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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,321	01/29/2004	John W. Taylor	9968-53U1	5500

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER
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UTAMA, ROBERT J

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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06/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/767,321	<b>Applicant(s)</b> TAYLOR ET AL.	
	<b>Examiner</b> Robert J. Utama	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01/29/2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/29/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :07/13/2005, 06/27/2005, 10/21/2004.

Art Unit: 3714

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1-10, drawn to A book encoded with optical page identification, classified in class 434, subclass 315.
  - II. Claim 11-14, drawn to book-housing to receive a book and having touch sensitive material, classified in class 434, subclass 317.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination Group I is a book encoded with optical code identification has separate utility such as a book for learning and entertainment purposes.

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper. See MPEP § 806.05(d).

Art Unit: 3714

4. During a telephone conversation with Mr. John Jameison on 06/18/2007 a provisional election was made with traverse to prosecute the invention of group I, claim 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claim 11-14 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1-10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 set forth a limitation of a first sequence of page identifiers and such sequence is associated with the first corresponding page spread. It is not clear from the claim language if other pages also contain these page identifiers or only the first page spread contains these page identifiers. Similar reasoning can also be applied to limitation of the second sequence page identifiers in claim 1. Claim 2-8 is also rejected due to its dependency to a rejected claim. Claim 9 is also rejected because it contains the same ambiguity of claim 1.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3714

**8. Claim 1-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Jeng US 4,809,246 and in view of Kim et al US 6,865,367**

**Claim 1:** Jeng provides a teaching of a book encoded for optical page identification (see Jeng FIG. 2 item H1-H3). Jeng provides a teaching of plurality of successive page spreads defined by plurality of pages (see Jeng FIG. 2 item 6a and 7a) and having a sequence of page identifiers with each identifiers correspond to a successive page spread having a overlayable arrangement of adjoining open and close hole location (see Jeng col. 3:40-52), each successive arrangement of the sequence increasing in total number of open hole location by at least one open hole location (see Jeng Col. 5:12-22).

Jeng does not provide a teaching of another set of page identifiers that correspond the other page spread, having an overlay-able arrangement of adjoining open and close hole location, each successive arrangement of the decreasing in total number of open hole location by at least one open hole location. However, Kim provides a teaching of another set of page identifiers that correspond the other page spread, having an overlay-able arrangement of adjoining open and close hole location, each successive arrangement of the decreasing in total number of open hole location by at least one open hole location (see Col. 4:45-65). Therefore, it would have been obvious for one ordinary skilled in the art to include the feature of another set of page identifiers that correspond the other page spread, having an overlay-able arrangement of adjoining open and close hole location, each successive arrangement of the decreasing in total number of open hole location by at least one open hole location, as taught by Kim, into the book-apparatus of Jeng because it would enable the code to support more page.

**Claim 2:** Jeng does not provide a teaching where each arrangement of the first sequence of the first page where at least one closed hole location having a first optical reflectance detectably different than a second optical of the first area adjacent to at least one closed-hole location. However, Kim provides a teaching at least one closed hole location having a first optical reflectance detectably different than a second optical of the first area adjacent to at least one

Art Unit: 3714

closed-hole location (see Kim col. 4:35-43). Therefore it would have been obvious to one of ordinary skill in the art to include the feature of at least one closed hole location having a first optical reflectance detectably different than a second optical of the first area adjacent to at least one closed-hole location, as taught by Kim, in order to increase the accuracy of the photo-sensors (see Kim col. 4:48-55).

Jeng does not provide a teaching of another set of page identifiers that correspond the other page spread. However, Kim provides a teaching at least one closed hole location having a third optical reflectance detectably different than a fourth optical of the first area adjacent to at least one closed-hole location (see Kim col. 4:35-43). Therefore, it would have been obvious for one ordinary skill in the art to include the feature of another set of page identifiers that correspond the other page spread, as taught by Kim, into the book-apparatus of Jeng because it would enable the code to support more page.

**Claim 3, 5, 7 and 8:** Jeng provides a teaching of having open hole location located on a page of the plurality of pages and is defined by an elongated closed perimeter opening through the page (see FIG 2 item H1-H3). Also Jeng's open hole location is located through the one page proximal a free page of a page (see FIG 2 item H1-H3).

**Claim 4 and 6:** Jeng does not provide a teaching of open hole that is defined by cutout extending inwardly from a proximal edge of the page. Instead Jeng provides a teaching of an elongated closed perimeter opening through the page

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to create a cutout extending inwardly from a proximal edge of the page. Because the applicant has not provide a particular advantage having create a cutout extending inwardly from a proximal edge of the page , or solved a particular problem. One of ordinary skill in the art would have expected that the elongated closed perimeter opening through the page and the proposed cutout extending inwardly from a proximal edge of the page to work, would be able to perform the same function of letting light reach the photo sensors.

Art Unit: 3714

Therefore, it would have been prima facie obvious to modify Jeng to obtain the invention as specified in claim 4 and 6 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Jeng.

**Claim 9:** Jeng provides a teaching of a book encoded for optical page identification (see Jeng FIG. 2 item H1-H3). Jeng provides a teaching of plurality of successive page spreads defined by plurality of pages (see Jeng FIG. 2 item 6a and 7a)

Jeng does not provide a teaching where each arrangement of the first sequence of the first page where at least one closed hole location having a first optical reflectance detectably different than a second optical of the first area adjacent to at least one closed-hole location. However, Kim provides a teaching at least one closed hole location having a first optical reflectance detectably different than a second optical of the first area adjacent to at least one closed-hole location (see Kim col. 4:35-43). Therefore it would have been obvious to one of ordinary skilled in the art to include the feature of at least one closed hole location having a first optical reflectance detectably different than a second optical of the first area adjacent to at least one closed-hole location, as taught by Kim, in order to increase the accuracy of the photo-sensors (see Kim col. 4:48-55).

Jeng does not provide a teaching of another set of page identifiers that correspond the other page spread. However, Kim provides a teaching at least one closed hole location having a third optical reflectance detectably different than a fourth optical of the first area adjacent to at least one closed-hole location (see Kim col. 4:35-43). Therefore, it would have been obvious for one ordinary skilled in the art to include the feature of another set of page identifiers that correspond the other page spread, as taught by Kim, into the book-apparatus of Jeng because it would enable the code to support more page.

**Claim 10:** Jeng provides a teaching of book having a sequence of page identifiers with each identifiers correspond to a successive page spread having a overlayable arrangement of adjoining open and close hole location (see Jeng col. 3:40-52), each successive arrangement of



Art Unit: 3714

the sequence increasing in total number of open hole location by at least one open hole location (see Jeng Col. 5:12-22).

Jeng does not provide a teaching of another set of page identifiers that correspond the other page spread, having an overlay-able arrangement of adjoining open and close hole location, each successive arrangement of the decreasing in total number of open hole location by at least one open hole location. However, Kim provides a teaching of another set of page identifiers that correspond the other page spread, having an overlay-able arrangement of adjoining open and close hole location, each successive arrangement of the decreasing in total number of open hole location by at least one open hole location (see Col. 4:45-65). Therefore, it would have been obvious for one ordinary skilled in the art to include the feature of another set of page identifiers that correspond the other page spread, having an overlay-able arrangement of adjoining open and close hole location, each successive arrangement of the decreasing in total number of open hole location by at least one open hole location, as taught by Kim, into the book-apparatus of Jeng because it would enable the code to support more page.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Utama whose telephone number is (571) 272-1676. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezutto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**KATHLEEN MOSSER**  
**PRIMARY EXAMINER**  
**ART UNIT 3714**